

### REMARKS/ARGUMENTS

The preceding amendments and following remarks are submitted in response to the non-final Office Action mailed March 22, 2005. With this Amendment, claims 20, 26, and 32 have been amended, and claims 37-42 have been added. Claims 20-42 remain pending in this application. Reconsideration, examination and allowance of all pending claims are respectfully requested.

#### Double Patenting Rejections

In paragraph 1 of the Office Action, the Examiner rejected claims 20, 22, 25-26, 28, 31-32 and 36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of Becker et al. (U.S. Patent No. 6,689,151). While acknowledging that the conflicting claims are not identical, the Examiner states that they are not patentably distinct from each other because the claims in the present application are broader than the claims in the patent. According to the Examiner, the structural limitations set forth in claims 20, 22, 25-26, 28, 31-32 and 36 are also claimed in the patent.

Applicant respectfully traverses the Examiner's rejection of claims 20, 22, 25-26, 28, 31-32 and 36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,689,151. An appropriate Terminal Disclaimer is submitted herewith, however, rendering these rejections moot. Applicant does not concede the correctness of the rejection.

#### 35 U.S.C. § 102(b) Rejections

In paragraph 4 of the Office Action, the Examiner rejected claims 20-36 under 35 U.S.C. § 102(b) as being anticipated by Becker et al. (U.S. Patent No. 6,165,152) (hereinafter "Becker '152").

Applicants respectfully assert that the Becker '152 reference fails to anticipate the delivery sheath of claims 20-36. The Becker '152 reference appears to disclose a balloon catheter (10) having an elongated catheter shaft (11), an inflatable balloon (14), and an adapter (16). The catheter shaft (11) includes an outer tubular member (20), an inner tubular member (21), and an inflation lumen (22) in fluid communication with the inflatable balloon (14). As can be clearly seen in the marked-up Figures 1-2 of Becker '152 provided on page 4 of the Office Action, the inflatable balloon (14) and not the

catheter shaft (11) increases in outer dimension at the location labeled as the "intermediate region" by the Examiner.

In contrast to Becker '152, independent claims 20, 26, and 32 recite a delivery sheath including, among other novel elements, an elongated sheath having an intermediate region increasing in outer dimension from a proximal end of the intermediate region to a distal end thereof. Such configuration can be seen, for example, in Figure 4 of the present Application, which shows a sheath (70) having an intermediate region (82,83) that increases in outer dimension from a proximal region 84 to a distal portion (72).

The location labeled as "intermediate region" by the Examiner corresponds to the location where the balloon material attaches to the catheter (10), and does not show an intermediation region of an elongated sheath increasing in outer dimension, as recited in claims 20, 26, and 32. Indeed, the only portion of the catheter (10) in Becker '152 that could reasonably be construed as the intermediate region of an elongated sheath is the outer and inner tubular members (20,21) depicted in that reference. As shown in Figure 2 of Becker '152, however, the outer tubular member (20) appears to have a relatively constant outer dimension along its length whereas the inner tubular member (21) actually decreases in outer dimension at a spiraled location (26). Thus, Applicants respectfully assert that the Becker '152 reference fails to disclose or suggest an elongated sheath having an intermediate region increasing in outer dimension from a proximal end of the intermediate region to a distal end thereof, as recited in claims 20, 26, and 32.

In addition, Applicants respectfully assert that the Becker '152 reference fails to disclose or suggest a delivery sheath. The Becker '152 reference appears to be directed towards methods of forming catheters having a flexible section using laser radiation. The Becker '152 reference does not appear to disclose or suggest a delivery sheath that could be used for transporting an intravascular filter other such device therein.

Because the Becker '152 reference fails to disclose or suggest each and every element of claims 20, 26, and 32, Applications respectfully assert that the rejection of these claims under 35 U.S.C. § 102(b) is improper. Moreover, because claims 20, 26, and 32 are patentable, dependent claims 21-25 and 27-31 are also patentable for the reasons given above, and since they contain other significant elements to distinguish

them from the cited prior art.

With respect to claims 25, 31, and 36, the Examiner further states in paragraph 6 of the Office Action that "the function recitation that the delivery sheath is configured to accommodate an intravascular emboli capturing device therein has not been given patentable weight because it is in narrative form." The Examiner further states that to be given patentable weight, a function recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. § 112, ¶ 6, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

Applicants respectfully assert that claims 25, 31, and 36 each recite structural limitations that further act to limit that recited in independent claims 20, 26, and 32. In addition to containing structural limitations not disclosed or suggested by the cited prior art, Applicants further assert that these claims are also patentable for the reasons provided above.

With this Amendment, claims 37-42 have been added, which Applicants submit are also patentable over the cited prior art.

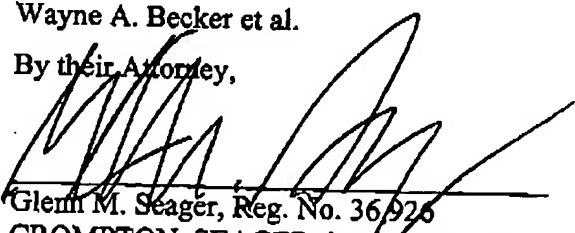
Examination of the claims in due course is respectfully requested. Applicants respectfully submit that all pending claims are in condition for allowance; issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Wayne A. Becker et al.

By their Attorney,

Date: May 11, 2005

  
Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050